

ESTTA Tracking number: **ESTTA366076**Filing date: **08/31/2010**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92052698
Party	Defendant AmeriCareers, LLC
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Submission	Answer and Counterclaim
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Signature	/Dan Ouyang/
Date	08/31/2010
Attachments	higheredspace_my_Answer_CC_final.pdf (12 pages)(21852 bytes)

Registrations Subject to the filing

Registration No	2688003	Registration date	02/18/2003
Registrant	INTERNET EMPLOYMENT LINKAGE, INC. 1010 Lake Street Oak Park, IL 60301 UNITED STATES		
Grounds for filing	The registered mark has become the generic name for the goods.		

Goods/Services Subject to the filing

Class 035. First Use: 1996/12/10 First Use In Commerce: 1996/12/10
All goods and services in the class are requested, namely: Personnel placement and recruitment services for academic professionals and faculty; providing access to data and the ability to manipulate data [related data] related to personnel placement and recruiting services, namely, employment candidate information, job finding tools, institutional profiles and job posting data for academic professionals and faculty; providing a website featuring information and weblinks in the field of employment for academic professionals and faculty

Registration No	2781127	Registration date	11/11/2003
Registrant	INTERNET EMPLOYMENT LINKAGE, INC. P.O. Box 06416 Chicago, IL 606060416 UNITED STATES		
Grounds for filing	The registered mark has become the generic name for the goods.		

Goods/Services Subject to the filing

Class 035. First Use: 1999/12/01 First Use In Commerce: 1999/12/01
All goods and services in the class are requested, namely: Personnel placement and recruitment services for academic professionals and faculty; providing access to data and the ability to manipulate data related to personnel placement and recruiting services, namely, employment candidate information, job finding tools, institutional profiles and job posting data for academic

professionals and faculty; providing a website featuring information and weblinks in the field of employment for academic professionals and faculty

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Internet Employment Linkage, Inc. d/b/a

HigherEdJobs

Petitioner,

v.

AmeriCareers, LLC

Registrant.

Cancellation No.: 92052698

Registration No.: 3,666,461

Trademark: **HIGHER ED SPACE**

Registered on: August 11, 2009

Registered by: AmeriCareers LLC

and

AmeriCareers, LLC

Counterclaim Petitioner,

v.

Internet Employment Linkage, Inc.

Counterclaim Registrant.

Counterclaim Petition for Cancellation

Registration Nos.: 2688003 and 2781127

Trademarks:

HigherEdJobs.com (Registration No. 2,688,003) was issued on: Feb. 18, 2003

HigherEdJobs.com (Registration No. 2,781,127) was issued on: Nov. 11, 2003.

Registered by: Internet Employment Linkage, Inc.

**AmeriCareers LLC's ANSWER TO PETITION FOR CANCELLATION
AND
COUNTERCLAIM PETITION FOR CANCELLATION**

ANSWER TO PETITION FOR CANCELLATION

Registrant, AmeriCareers LLC, in this proceeding hereby answers the Petition for Cancellation ("the Petition") as follows:

For the preceding paragraph of the Petition, Registrant admits that Registrant registered the Mark “HIGHER ED SPACE (Registration No. 3,666,461) on August 11, 2009 for “On-line computer services, namely, providing a web-based system and online portal for higher education communities with online directories featuring colleges, graduate schools, courses, scholarships, jobs, news, events, classified ads, virtual community and social networking” in International Class 41. But Registrant denies the rest of allegations contained in the preceding paragraph of the Petition.

1. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 1 of the Petition, and therefore denies the same.
2. Registrant admits to the extent as shown in the records in the database of The United States Patent and Trademark Office.
3. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 3 of the Petition, and therefore denies the same.
4. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 4 of the Petition, and therefore denies the same.
5. Registrant admits that Registrant filed Registrant’s application to register Registrant’s Mark (Application Serial No. 77,659,837). Registrant is without knowledge or information sufficient to form a belief as to the truth for the rest of allegations contained in the paragraph 5 of the Petition, therefore denies same.

6. Registrant admits that Registrant's Registration No. 3,666,461 was issued by the United States Patent and Trademark Office. Registrant is without knowledge or information sufficient to form a belief as to the truth for the rest of allegations contained in the paragraph 6 of the Petition, therefore denies same.
7. Registrant denies the allegations contained in the paragraph 7 of the Petition.
8. Registrant admits that Registrant filed an intent-to-use application for the Registrant's Mark on January 30, 2009 which later matured into registration, but denies the rest of allegations contained in the paragraph 8 of the Petition.
9. Registrant denies the allegations contained in the paragraph 9 of the Petition.
10. In answering the paragraph 10 of the Petition, Registrant re-answers and incorporates herein by reference the answers to the allegations made in paragraphs 1 through 9, above, as if set forth in their entirety herein.
11. Registrant denies each and every allegation contained herein of the paragraph 11 of the Petition.
12. Registrant denies each and every allegation contained herein of the paragraph 12 of the Petition.
13. Registrant denies each and every allegation contained herein of the paragraph 13 of the Petition.
14. In answering the paragraph 14 of the Petition, Registrant re-answers and incorporates herein by reference the answers to the allegations made in paragraph 1 through 13, above, as if set forth in their entirety herein.
15. Registrant denies allegations contained in the paragraph 15 of the Petition.
16. Registrant admits the allegations contained in the paragraph 16 of the Petition.

17. Registrant denies the allegations contained in the paragraph 17 of the Petition.
18. Registrant denies the allegations contained in the paragraph 18 of the Petition.

AFFIRMATIVE DEFENSES

1. Petitioner has not been and will not be damaged by the registration of the trademark “HIGHER ED SPACE” and therefore lacks standing to petition to cancel the registration.
2. Petitioner is barred from seeking cancellation of the Registrant’s trademark under the doctrines of: laches, estoppel, waiver and unclean hands.
3. Registrant’s Mark for “HIGHER ED SPACE” and Petitioner’s alleged Marks for “HigherEdJobs.com” and “HigherEdJobs” are dissimilar in that they differ significantly in appearance, sound and commercial impression. The differences in the marks are sufficient to preclude a likelihood of confusion.
4. Registrant’s Mark for “HIGHER ED SPACE” and Petitioner’s alleged Mark for “HigherEdJobs.com” are registered under two different International Classes. Registrant’s Mark for “HIGHER ED SPACE” was registered under IC 041 while Petitioner’s alleged Mark for “HigherEdJobs.com” was registered under IC 035. The two marks differ in the class, type and scope of their respective services.
5. Registrant’s first use of its Mark for “HIGHER ED SPACE” in International Class 041 was prior to the first use of Petitioner’s alleged Mark for “HigherEdJobs” in the same class. Registrant first used its Mark “HIGHER ED SPACE” under International Class 041 on April 18, 2009. Petitioner claimed its first use of their alleged Mark “HigherEdJobs” under International Class 041 on

January 01, 2010. Therefore, Registrant's rights in and to Registrant's Mark are superior to Petitioner's alleged Marks under the class IC 041 by virtue of Registrant's prior use of Registrant's Mark.

6. Registrant's Mark in its entirety when used in connection with Registrant's services is dissimilar to Petitioner's alleged Mark in its entirety used in connection with Petitioner's services, unlikely to cause confusion, mistake or deception and without injury to the Petitioner and the public.
7. Petitioner's claims against Registrant's Mark, in whole or in part, are barred because Registrant has acted within its rights and in good faith.
8. The USPTO examining attorney who approved Registrant's mark "HIGHER ED SPACE" for registration had not found any prior registered or pending marks that might be confusingly similar to Registrant's Mark in that time. That means that Registrant's Mark "HIGHER ED SPACE" (Registration No. 3,666,461) is not similar to Petitioner's alleged mark "HigherEdJobs.com" (Registration Nos. 2,688,003 and 2,781,127).
9. The USPTO examining attorney who examined Petitioner's application for registering their alleged mark "HigherEdJobs" (Application Serial Nos. 77950871 and 77950843) had twice indicated that no prior registered or pending marks found to be confusingly similar to Petitioner's alleged mark in that time. That means that Petitioner's alleged Mark "HigherEdJobs" is not similar to Registrant's registered Mark "HIGHER ED SPACE" (Registration No. 3,666,461).

10. There are other registered marks comprised of or including the words “higher ed”, “jobs” and close variations thereof in connection with higher education jobs.
- Petitioner neither owns exclusive rights to the words “higher ed”, nor the word “jobs” for the job advertising service or in the field of higher education. Petitioner is not entitled to such protection that could prevent Registrant from registering Registrant’s mark.
11. The term “higher ed” commonly refers to “higher education”. The terms “higher ed jobs” and “higher education jobs” are interchangeable, which commonly refer to employment opportunities in the field of higher education. The terms “higher ed jobs” and “higher education jobs” commonly refer to a category of jobs, or a type of jobs, i.e. a whole class of jobs in the field of higher education. The term “higher ed jobs” is or becomes generic. Thus, Petitioner’s alleged Marks “HigherEdJobs.com” and “HigherEdJobs” do not function as trademarks.
12. Petitioner’s marks “HigherEdJobs.com” and “HigherEdJobs” are merely descriptive of Petitioner’s services, and have not acquired distinctiveness. There are numerous websites that use the term “higher ed jobs” or “higher education jobs” for their descriptive uses. In fact, Petitioner allows so many others to use the term “higher ed jobs” or “higher education jobs” without objection, which indicates that Petitioner acknowledges and accepts that anyone can use Petitioner’s alleged marks. Petitioner’s use of Petitioner’s alleged marks is not substantially exclusive and Petitioner’s alleged marks have not acquired distinctiveness as a source identifier of goods or service and do not function as trademarks.

WHEREFORE, Registrant requests that the Petition for Cancellation be dismissed with prejudice, and the Registrant's registration be maintained on the Principal Register.

COUNTERCLAIM PETITION FOR CANCELLATION

AmeriCareers LLC, (hereinafter "Counterclaim Petitioner" or "CC-Petitioner" or "Petitioner"), a Michigan limited liability company having a principal place of business at 5000 Northwind Dr., Suite 218, East Lansing, Michigan 48823, believes that it is or will be damaged by Registration Nos. 2,688,003 and 2,781,127, and herein petitions to cancel the same.

To the best of Counterclaim Petitioner's knowledge, Counterclaim Registrant Internet Employment Linkage Inc. (hereinafter "Counterclaim Registrant" or "CC-Registrant" or "Registrant") having a principal place of business in Oak Park, Illinois 60301 is the current owner of Registration Nos. 2,688,003 and 2,781,127. Description of Counterclaim Registrant's registrations: "HIGHEREDJOBS.COM" (Registration No. 2,688,003) filed on March 30, 2001 and registered on February 18, 2003 on the Principal Register in International Class 035 for "Personnel placement and recruitment services for academic professionals and faculty; providing access to data and the ability to manipulate data [related data] related to personnel placement and recruiting services, namely, employment candidate information, job finding tools, institutional profiles and job posting data for academic professionals and faculty; providing a website featuring information and weblinks in the field of employment for academic professionals and

faculty.” claiming its first use on December 10, 1996 and its first use in commerce on December 10, 1996. “HIGHEREDJOBS.COM” and DESIGN (Registration No. 2,781,127) filed March 30, 2001 and registered on November 11, 2003 on the Principal Register in International Class 035 for “Personnel placement and recruitment services for academic professionals and faculty; providing access to data and the ability to manipulate data related to personnel placement and recruiting services, namely, employment candidate information, job finding tools, institutional profiles and job posting data for academic professionals and faculty; providing a website featuring information and weblinks in the field of employment for academic professionals and faculty.” claiming its first use on December 01, 1999 and its first use in commerce on December 01, 1999.

As grounds of this Counterclaim Petition, it is alleged that:

1. CC-Registrant’s alleged Marks, “HigherEdJobs.com”, consist primarily of the generic term “higher ed jobs”. The term “higher ed” commonly refers to “higher education”. The terms “higher ed jobs” and “higher education jobs” are generic and interchangeable, which commonly refer to employment opportunities (i.e. jobs) in the field of higher education. In other words, the term “higher ed jobs” commonly refers to the category of jobs or the type of jobs in the field of higher education. CC-Petitioner is or will be damaged by registration of the generic term “higher ed jobs” in that the prima facie effect of such registration impairs CC-Petitioner’s right to use the said generic term to categorize jobs in the field of higher education or to describe the related service and information. CC-Registrant is not entitled to continue registration of its alleged marks in that CC-Registrant is

not entitled to exclusive use of said generic term in commerce in connection with its services specified.

2. The term “higher ed jobs” or “higher education jobs” falls in the definition of genericness as they are commonly used to name and describe a class of goods or services, i.e. the entire class of jobs in the field of higher education. Without using the term “higher ed jobs” or “higher education jobs”, it would be difficult to find an alternative term to exactly and precisely describe and categorize the type of jobs or job related information and services in the field of higher education. CC-Registrant is not entitled to exclusive use of this useful and generic term “higher ed jobs”. Thus, CC-Registrant’s registrations should be cancelled.
3. CC-Registrant’s alleged marks “HigherEdJobs.com” are merely descriptive of CC-Registrant’s services and have not acquired distinctiveness. There are other websites that use the term “higher ed jobs”, and even more websites use the term “higher education jobs” and close variants. The term “higher ed jobs” or “higher education jobs” is as same as CC-Registrant’s alleged Marks by sound, meaning and commercial impression. In fact, CC-Registrant allows so many others to use the terms “higher ed jobs” or “higher education jobs” without objection, which indicates that CC-Registrant acknowledges and accepts that anyone can use CC-Registrant’s alleged marks. In addition, the term “higher ed jobs” or “higher education jobs” only describes the category of the goods or service, does not identify the source of the goods and services. Therefore, CC-Registrant’s alleged marks “HigherEdJobs.com” are or become generic and further, that CC-Register’s use of CC-Registrant’s alleged marks is not substantially exclusive. CC-

Registrant's alleged marks have not acquired distinctiveness and do not function to identify CC-Registrant's services and distinguish them from those offered by others.

4. CC-Registrant's alleged Marks, "HigherEdJobs.com", are comprised of an Internet domain name (i.e. the generic term "higher ed jobs" followed by ".com") which is not registerable unless the term itself functions as an identifier of the source of goods or services. A top level domain name such as ".com" functions solely to indicate an address on the World Wide Web, and therefore, serves no source-identifying function. The addition of a generic or otherwise unregisterable term to a top level domain name, or the omission of spaces between words, has no trademark significance and does not render the term "HigherEdJobs.com" registerable. Thus, since the term "higher ed jobs" is generic, "HigherEdJobs.com" is not registerable as a trademark.
5. Based on the above, CC-Registrant's alleged marks do not function as trademarks.

WHEREFORE, the Counterclaim Petitioner prays that this Counterclaim Petition for Cancellation be sustained, and that the two trademark registrations, Registration Nos. 2,688,003 and 2,781,127, be cancelled.

The Counterclaim Petition for Cancellation is filed herewith, along with the required fees.

Date: 8/31/2010

Respectfully submitted,

AmeriCareers, LLC

By: /Dan Ouyang /

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing document is being deposited with the United States Postal Service with sufficient postage as first class mail, on the date set forth below in an envelope addressed to:

ELIZABETH R. BURKHARD
HOLLAND & KNIGHT LLP
10 ST. JAMES AVENUE, 11TH FLOOR
BOSTON, MA 02116

Date: 8/31/2010

/Dan Ouyang/